



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,064	09/13/2000	Donald Eugene Brodnick	GEMS8081.040	7626

27061 7590 04/16/2003

ZIOLKOWSKI PATENT SOLUTIONS GROUP, LLC (GEMS)
14135 NORTH CEDARBURG ROAD
MEQUON, WI 53097

EXAMINER

KHAN, OMAR A

ART UNIT	PAPER NUMBER
----------	--------------

3762

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/661,064

Applicant(s)

BRODNICK ET AL.

Examiner

Omar A Khan

Art Unit

3762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Response to Arguments.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-15

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Response to Arguments

1. Applicant's arguments filed 4/4/2003 have been fully considered but they are not persuasive.

Applicant's arguments regarding finality of the previous Action have been considered. Applicant has correctly stated that in order to anticipate a claim, a reference must teach each and every element of the claim and that Applicant is not obligated to respond to an unsubstantiated rejection. As stated in the first action, the art "clearly anticipated" the claims. As such, since the claimed invention was clearly anticipated, no discussion is needed. This is a well-established policy practiced by the USPTO for many years. Further, the Applicant has not only responded but further demonstrated, by overcoming the 102 rejections made in first Non-Final Action and submitting a declaration to overcome the new rejections made in the second Final Action, that the claimed invention was, as the Examiner stated, clearly anticipated.

With regards to claim 1, Murphy teaches the claimed invention throughout the specification and claims but, in particular, discloses a plurality of lead wires (column 4, lines 41-59), a portable, on-demand ECG monitor (column 4, lines 41-59), having a processor (column 4, line 60), and a wireless communication interface (column 6, lines 9-54).

In response to Applicant's argument that neither David nor Bornn disclose a 12-lead ECG apparatus, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art at the time the invention was made. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

Art Unit: 3762

1981). At the time the invention was made, the use of 12-lead ECG monitors and conversion apparatuses for converting between non-standard lead configurations and 12-lead configurations were well known in the art and widely used as a standard. It would, therefore, have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ECG communication methods and apparatuses of David and Bornn to include a 12-lead ECG configuration which, due its prevalence at the time the invention was made, would be more readable and easily understandable by medical personnel for more accurate diagnoses. Further, Applicant's claim 1 states "a *standard* [emphasis added] 12-lead ECG configuration" implicitly stating that a 12-lead ECG configuration was well known in the art at the time the invention was made. Applicant's argument that Bornn teaches away from a 12-lead ECG configuration is not persuasive. Applicant is referring to a specific embodiment of the prior art of Bornn. The specification clearly states in column 9, lines 10-16 that "other numbers of electrodes can be used within the spirit of the invention" and that "they can be configured in a number of different ways". In addition, the claim does not state that *all* the 12 lead signals are produced, rather, that the lead wire is *capable* of receiving an ECG signal of a 12-lead configuration and produce standard 12 lead data.

In response to Applicant's argument that David does not disclose transmission of data that has been processed, David discloses in column 10, lines 16-19 that "the health monitoring and sensing equipment measures the medical condition of the patient and generates a signal representative of the measured medical condition" which is considered processing.

In response to Applicant's argument that David does not disclose a portable device, the definition of the word portable in Merriam-Webster's 10th Collegiate Dictionary is "capable of

Art Unit: 3762

being carried or moved about". Therefore, the scope of the claimed limitation "portable" encompasses almost every conceivable object or structure. In Figure 6, the ECG apparatus of David is disclosed as being located on a chair, which is portable. The claimed limitation "portable" amounts to a recitation of the intended use of the claimed invention, which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to Applicant's argument that Bornn does not disclose an on-demand ECG monitor. Similar to the previous argument, the ECG monitor of Bornn is an on-demand ECG monitor when the patient is within the communication range and wearing the torso band. The claimed limitation "on-demand" amounts to a recitation of the intended use of the claimed invention, which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant's remaining arguments regarding the 103 rejections made in the previous action are a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

2. The declaration filed on 4/4/2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Murphy reference.

The declaration must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and

Art Unit: 3762

may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.


The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Murphy reference to either a constructive reduction to practice or an actual reduction to practice. The declaration submitted does not constitute demonstrative evidence, particularly since there is no date associated with the evidence other than the inventors' allegation that the evidence was produced prior to the effective date of the Murphy reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar A Khan whose telephone number is (703) 308-0959. The examiner can normally be reached on M-F 9AM-6PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.

 4/14/03
Omar A Khan
April 14, 2003


GEORGE R. EVANISKO
PRIMARY EXAMINER

4/14/03